



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Patent Examining Operations

Applicant(s): Stephen Horrigan

Serial No: 09/964,824 Art Unit: 1631

Filed: 27 September 2001 Examiner: C.L Smith

Title: CANCER GENE DETERMINATION AND THERAPEUTIC
SCREENING USING SIGNATURE GENE SETS

Docket No: 609290-73

#17/a
Plunkett
6/3/03

23 May 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT

Sir:

Prior to examination on the merits, Applicants request that the application be amended as follows:

06/03/2003 TPLUNKET 00000002 030678 09954824

01 FC:2201 42.00 CH



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Patent Examining Operations

Applicant(s): Stephen Horrigan

Serial No: 09/964,824 Art Unit: 1631

Filed: 27 September 2001 Examiner: C.L Smith

Title: CANCER GENE DETERMINATION AND THERAPEUTIC
SCREENING USING SIGNATURE GENE SETS

Docket No: 609290-73

23 May 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

MAY 29 2003

TECH CENTER 1600/2900

ELECTION OF INVENTION

Sir:

In response to the Office Action, dated 31 January 2003, Applicants respond by electing the claims of Group I (claims 1-21) drawn to a process for screening for agents having cancer-gene related modulating activity with traverse.

Applicants believe that the claims of Group VI (claims 35-39 and 41) and Group VII (claims 42-45), drawn to a method of treating cancer or protecting from cancer, should be combined with Group I for examination with the claims limited to use of compounds having activity in the screening claims.

The Office Action notes that each group also requires election of a particular

Serial No.: 09/964,824
Filed: 27 September 2001

sequence for examination. Applicant notes that, in speaking with the Examiner, it was agreed that in this line of cases (beginning with Application Serial No. 09/873,367) Applicant would elect 10 gene sequences and amend claim 1 to require a determination of modulation of more than one gene. This is accomplished in the accompanying Preliminary Amendment.

Applicant has therefore selected 10 sequences denoted in the application as SEQ ID NO: 137, 164, 174, 180, 191, 199, 344, 381, 390 and 465. The selection of these sequences is made clearer by reference to the accompanying Preliminary Amendment.

The GenBank accession numbers for these sequences are: 137 (AA426220), 164 (AA004887), 174 (AA281006), 180 (AA490819), 191 (N71063), 199 (AA243738), 344 (AA411711), 381 (N73808), 390 (R27957) and 465 (H05625). These Accession Numbers were reported in the Figures accompanying the priority provisional applications on which the present case is based, the disclosures of which were incorporated by reference in their entirety, and are presented here only to facilitate the Examiner's search.

Applicants have also amended some claims in accordance with previous discussions with the Examiner as well as to remove certain improper multiple claim dependencies. In addition, Applicants have amended claim 1 and others to better reflect the nature of the invention. Such amendments are contained in the accompanying Preliminary Amendment. A new sequence diskette is also included as part of this response.

Applicant includes herewith a request for a 3 month extension of time to respond plus a check to cover the fee. The Commissioner is authorized to charge payment of any additional filing fees required under 37 CFR 1.16 associated with this communication or credit any overpayment to Deposit Account No. 03-0678.

Serial No.: 09/964,824
Filed: 27 September 2001

FIRST CLASS CERTIFICATE

I hereby certify that this correspondence is being deposited today with the U.S. Postal Service as First Class Mail in an envelope addressed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Alan J. Grant 5/23/03
Alan J. Grant, Esq. Date

Respectfully submitted,



Alan J. Grant, Esq.
Reg. No. 33,389

CARELLA, BYRNE BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN
Six Becker Farm Road
Roseland, NJ 07068
Phone: 973-994-1700
Fax: 973-994-1744